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Docket No.: 2001 P 13459 US  
App. No.: 09/917,373

AUG 02 2006

**REMARKS**

Claims 13 and 16-20 are pending in the Application. Claims 1-12 and 14-15 have been canceled without prejudice.

*Claim Rejections - 35 U.S.C. § 102*

The Patent Office rejected claims 1-2, 4, 8 and 10-12 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,657 by Barnard et al., ("Barnard").

Applicant respectfully traverses; however, claims 1-12 have been canceled without prejudice, thus the rejection is now moot.

*Claim Rejections - 35 U.S.C. § 103*

The Patent Office rejected claims 3, 5, 13, 16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,859,657 by Barnard et al., ("Barnard").

The Patent Office rejected claims 9, 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,859,657 by Barnard et al., ("Barnard") in view of U.S. Patent No. 6,438,245 by Taenzer et al., ("Taenzer").

Applicant respectfully traverses each rejection under 35 U.S.C. § 103(a). Applicant respectfully submits claims 13 and 19 recite novel and nonobvious elements which have not been disclosed, taught or suggested by Barnard and Taenzer. For example, claim 13 generally recites a concealed telephony system including a telephone (12, 52) which includes a keyboard and display that can make and receive telephone calls; a pair of glasses (16); an earpiece (14, 54) that provides audio signals from the telephone to an ear of a user, the earpiece being integrated within a sidepiece of the pair of glasses. Emphasis added. Claim 19 generally recites a concealed telephony system including a telephone (12, 52) which includes

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a keyboard and display that can make and receive telephone calls; a earring; a bracelet; an earpiece (14, 54) that provides audio signals from the telephone to an ear of a user, the earpiece being integrated within the earring.

The Patent Office correctly states that Barnard fails to teach, disclose or suggest an earpiece being integrated within a sidepiece of a pair of glasses. Additionally, the Patent Office correctly states that Barnard fails to teach, disclose or suggest an earpiece being integrated within an earring. However, the Patent Office further states that it would have been obvious for a person of ordinary skill in the art to mount an earpiece within the sidepiece of a pair of eyeglasses and mount an earpiece within an earring based upon Barnard.

Applicant respectfully traverses. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or the knowledge generally available to one of ordinary skill in the art." *M.P.E.P.* §2143.01. Emphasis added.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated

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that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

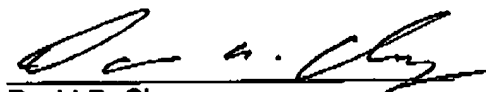
Barnard does not provide any motivation to mount an earpiece within a pair of glasses or an earring. In fact, Barnard teaches away from such the combination of elements recited in claims 13 and 19. Barnard discloses a system which requires a the use of a user's skin to transmit signals between the earpiece and microphone. (Barnard, Abstract, Column 3, Lines 54-57 and FIG. 4.) Consequently, a person of ordinary skill in the art would not look to mounting an earpiece on a device which was not coupled directly to a user's skin, such as an earring or a pair of glasses. Thus, Barnard fails to provide any motivation to for mounting an earpiece within a an earring or a pair of glasses. Consequently, claims 13 and 19 should be allowed. Claims 16-18 and 20 should be allowed as being dependent upon an allowable base claim.

#### Conclusion

Applicants respectfully submit that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

Respectfully Submitted,

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